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Remarks

Claims 1-21 are currently pending in the above-captioned matter. By this amendment, claim 19 has been amended. After entry of this amendment, claims 1-21 are pending, claims 1 and 19 being independent. Remarks made herein are based on the claims as amended hereby.

Objections

The Examiner objected to claims 19 -21 for a typographical error. The application has been amended to correct the objected to item. Applicants respectfully request that the objections be withdrawn.

35 USC §102 and §103 Rejections

Claims 1-14 and 18-21 were rejected under 35 USC §102 as anticipated by, or in the alternative under 35 USC §103 as obvious over Japanese Patent Document No. JP 08-258214 to Katsumi et al. (the '214 patent document).

Claims 1-21 were rejected under 35 USC §102 as anticipated by, or in the alternative under 35 USC §103 as obvious over Japanese Patent Document No. JP 06-145559 to Morita et al. (the '559 patent document).

Applicants respectfully traverse the rejection. As the Office is no doubt aware, a rejection under 35 U.S.C. §102 can only be maintained if single reference teaches each and every element of the claims. Applicants respectfully submit that the mere possibility of picking and choosing various constituents arguably disclosed in a single reference does not amount to anticipation. As such, a rejection under §102 is considered to be inappropriate since the Examiner cannot ignore any differences between the claims and the reference. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

As recited in the Official Action dated February 20, 2003, neither the '214 patent

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document nor the '559 patent document explicitly teach a ratio of the nitrogen in urea bonds to the nitrogen participating in the isocyanate reaction, which is the proportion of nitrogen atoms pertaining to urea bonds out of the nitrogen atoms participating in the isocyanate reaction during synthesis of said water-based urethane resin, that is between 10/100 and 90/100.

The Examiner has stated that "Because the carboxyl group content is directly related to the urea content, it is believed that the disclosed carboxyl content corresponds to a urea content that would have inherently overlapped the claimed range of the instant invention". Applicants respectfully submit that, there is no evidence supporting the conclusion that the disclosed carboxyl group content is directly related to the amount of urea bonds such that the acid number per urethane solid content would definitely result in a ratio of the nitrogen in urea bonds to the nitrogen participating in the isocyanate reaction that is between 10/100 and 90/100. Although the diamino carboxylic acid of the references could contribute some urea bonds, there is no evidence of a 1:1 correlation. Accordingly, the rejection under 35 U.S.C. §102 should be withdrawn.

Furthermore, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the claims as amended.

In order to support a rejection under 35 U.S.C. §103, the Office must establish that there was some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Office may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski* 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed

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combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

There is no teaching or suggestion in the references to select a particular ratio of the nitrogen in urea bonds to the nitrogen participating in the isocyanate reaction in order to achieve the desired improvement in performance of low and high speed marring resistance as seen in Table 3. There is also no suggestion as to the desirability of controlling this particular ratio in either reference. Applicant submits that the Office has not established that the cited references teach or suggest how to modify what is disclosed to arrive at the claimed invention, nor does the prior art as a whole suggest the desirability, and, thus, the obviousness, of making the modification. Applicants respectfully submit that the mere possibility of picking and choosing various constituents arguably recited in the prior art to achieve Applicants' invention is improper hindsight.


Moreover, even assuming that a *prima facie* case of obviousness were made out by the foregoing references, Table 3 of the instant application shows surprising results, when the particular nitrogen ratios of claims 1 and 19 are used. Comparing Example No. 4, 8 and 9 with Comparative Examples 17 and 18 shows that selecting the claimed ratios of the nitrogen in urea bonds to the nitrogen participating in the isocyanate reaction provides improved performance in all categories. Notably, the inventive composition provided no marring versus 5% or more marring in the comparative examples and corrosion resistance was at least 3 times better up to at least 10 times better. These improved results would not be expected from merely selecting particular ratios of nitrogen, and are evidence that this invention would not have been obvious from the cited references to one of ordinary skill in the art at the time the invention was made. Accordingly, the rejections under 35 USC §102 and §103 should be withdrawn.

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Conclusion

Applicants request reconsideration in view of the amendments and remarks contained herein. Applicants submit that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned.

Respectfully submitted,


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